

Remarks

Receipt is acknowledged of the Office Action mailed July 9, 2004. Claims 1-15 are pending. Claims 1, 8, 12 and 14 remain withdrawn from consideration. Claims 2-7, 9-11, 13 and 15 are under consideration. Claims 3, 4 and 5 have been canceled. New claims 16 and 17 have been added. No new matter is added with the amendments, which are fully supported by the specification.

I.     Objections

The Examiner maintains her objection to the specification for the incorporation of essential material in the specification on page 5, lines 4-6, by reference to a foreign application or patent. The examiner requires amendment to the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application.

In view of the above amendment, wherein the claims recite a specific amino acid or DNA sequence, applicants believe this objection is rendered moot. Withdrawal thereof is therefore respectfully requested.

## II. Rejections under 35 USC § 112

### (a) Second Paragraph

The Examiner maintains her rejection of Claims 2-7, 9-11, 13 and 15 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The allegedly indefinite language (i.e., "functional" and "derivable" has been deleted; therefore, this rejection should be withdrawn.

### (b) First Paragraph

Claim 3 is rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is rendered moot with the cancellation of claim 3.

Claim 10 is rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The Examiner disputes the written support for the production of a protein into a cell culture, noting that in one embodiment, the leader sequence inserts the protein into the cell membrane. In response, applicants point out that the Examiner is relying upon a description of but one embodiment of the invention. However, in order to move this case to allowance, applicants herewith amend claim 10 to recite a method of "expressing" the protein. Thus, the further step of the protein being isolated from a cell culture is not recited, although this subsequent step is not excluded from the claim either.

Applicants believe this claim satisfies all statutory requirements and therefore should be allowed.

Claims 6, 7 and 9 also are rejected under 35 USC § 112, first paragraph, for lack of enablement. According to the Examiner, the specification only enables a method of using host cells comprising the DNA of claim 2 *in vitro* or *ex vivo*, and an *in vitro* or *ex vivo* method of endowing CTL with a MHC-independent and unrestricted tumor cell specificity comprising introducing the DNA of claim 2 into the T-cell. Applicants respectfully traverse this rejection but wish to move this case to allowance as quickly as possible. Accordingly, applicants have amended claims 6 and 9 to recite *in vivo* or *ex vivo*. Claim 7 depends from claim 6. Allowance of claims 6, 7 and 9 is respectfully requested.

### III. Rejections under 35 USC § 103

The Examiner maintains her rejection of claims 2, 4-7, 9-11, and 15 under 35 USC §103(a) as being unpatentable over Capon et al. (WO 92/10591, reference AC of the IDS filed September 19, 2000) in view of Wels et al. (EP 502,812, reference AP of the IDS filed September 19, 2000) and Huse et al. (Science, 1989, Vol. 246, pp. 1275-1281) is maintained for reasons of record. Claim 13 is also rejected for the same reasons of record.

Applicants respond by noting that this rejection is moot with regard to the canceled claims and inapplicable to the amended and new claims, which recite or incorporate through dependency the amino acid sequence of SEQ ID NO: 7. The combined teachings of the cited prior art nowhere

teaches of suggests this sequence and the Examiner has not argued that it does. Accordingly, applicants respectfully request the Examiner to withdraw the rejection for obviousness and allow the remaining and new claims.

Conclusion

In view of the above amendment and remarks, applicants respectfully request that all objections and rejections be withdrawn and that a notice of allowance be forthcoming. The Examiner is invited to contact the undersigned attorney for applicants at 202-912-2142 for any reason related to the advancement of this case.

Respectfully submitted,

Date: January 7, 2005

Heller Ehrman White & McAuliffe LLP  
1666 K Street, N.W., Suite 300  
Washington, D.C. 20006-4004  
Telephone: (202) 912-2000  
Facsimile: (202) 912-2020

Patricia D. Granados

Patricia D. Granados  
Attorney for Applicant  
Reg. No.: 33,683

Customer No. 26633